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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Paul DeAngelis)	Group Art Unit:	1632
)		
Serial No.:	09/842,484)	Examiner:	Not Yet Assigned
)		
Filed:	April 25, 2001)	Atty. Dkt. No.:	5820.601
)		
For:	CHONDROITIN SYNTHASE)		
	GENE AND METHODS OF)		
	MAKING AND USING SAME)		

Commissioner for Patents
Washington, D.C. 20231

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PETITION UNDER 37 C.F.R. §1.182

Applicants herein respectfully petition the Commissioner under 37 C.F.R. §1.182 to: (1) accept Fig. 2 (submitted herewith) into the present application and (2) accord the application, including Fig. 2, the original filing date of April 25, 2001. A memorandum of law and facts in support of this petition and the requisite filing fee are attached hereto.

**Memorandum of Law and Facts in Support of the
Petition Under 37 C.F.R. §1.182**

In the "Notice of Omitted Parts", the PTO informed the Applicants that Figure 2, while mentioned in the specification, had not actually been submitted by the Applicants when the application was originally filed. The PTO further informed the Applicants that one of two options existed:

1. Petition the PTO and contend that Fig. 2 had indeed been submitted; or
2. Supply the omitted item and accept the filing date of the submission of Fig. 2 as

the filing date of the application.

The Applicants cannot claim that Fig. 2 was submitted – it is clear that this figure was not submitted to the PTO when the application was originally filed. Additionally, the Applicants cannot accept the date of submission of Fig. 2 as the filing date of the application – to do so would break the co-dependency between the present application and the provisional application to which it is related.

As such, the Applicants respectfully petition the Commissioner to accept Figure 2 and grant it the original filing date of the application, i.e. April 25, 2001. The granting of such a petition is more than appropriate given the fact that:

- (A) The description of Fig. 2 given in the Specification at p. 9 and the further description at pp. 29 and 62 is more than adequate to put the information actually contained in Fig. 2 into the hands of one of ordinary skill in the art – i.e. one of ordinary skill in the art would recognize and understand the possible graphical representation of the data as shown in Fig. 2. As such, no new matter is being added to the application through the addition of Fig. 2 and the entire application including Fig. 2 is entitled to the original filing date.
- (B) Fig. 2 describes an inherent property of the disclosed device. According to MPEP 2163.07(c), amendments may be made to render an inherent function, theory, or property explicit. Thus, no new matter is being added to the application through the addition of Fig. 2, and the entire application including Fig. 2 is entitled to the original filing date.

The Applicants describe the data graphically represented in Fig. 2 in exacting detail in several instances in the specification. The discussion in the specification clearly enables one of ordinary

skill in the art to recognize that a graphical portrayal of the information, as shown in Fig. 2, exists and is possible. In addition, the data portrayed in Fig. 2 depicts an inherent physical property of the disclosed invention. As such, the addition of Fig. 2 does not add any new matter to the specification and its addition to the specification should be entitled to the original filing date.

MPEP 2163.07(a) states that the disclosure of a device that inherently performs a function or has a property, operates according to a theory or has an advantage necessarily discloses that function, theory or advantage even though it may not be explicitly stated. The MPEP goes on to state that the specification may later be amended to make the inherent function, theory, or advantage explicit. The graphical data of Fig. 2 makes explicit the property described in the specification. Such an addition is not considered new matter.

The MPEP cites *In re Reynolds*, 58 C.C.P.A. 1287, 443 F.2d 384, 170 U.S.P.Q. 94, (C.C.P.A., 1971) for the proposition that a figure was used to support a claim to an inherent function despite the failure of the applicant to explicitly recite the function in the specification. Id. at 1293. The court held that the inherent function is disclosed whether explicitly disclosed or not. Id. The court reasoned that “a person of ordinary skill in the art would suspect that there was some reason for the relationship shown in the drawing and would not regard such disclosure as accidental or arbitrary.” Id. In the present case, the Applicants have explicitly described the data and relationship contained in an omitted figure (Fig. 2). The data contained in Fig. 2 and described in the specification refers to an inherent property of the disclosed device. One of ordinary skill in the art would recognize the description in the specification of the data in Fig. 2 as having a graphical representation. Therefore, Fig. 2 is not new matter and depicts an inherent physical property as provided by MPEP 2163.07(a).

Discussing *Reynolds*, the court in *Kennecott Corp. v. Kyocera Intern, Inc.*, 835 F.2d 1419, 1422, 5 U.S.P.Q.2d 1194, 1194 (Fed.Cir.(Cal.) 1987), held that the addition of the microstructure of the claimed product of the parent application was not new matter because the product in the subsequent patent was the same and the microstructure of the product is an inherent property existing at the time of the parent application. *Id.* at 1423. The court further held that an applicant is entitled to the benefit of the parent application's filing date where the structure was an inherent property of the product sought to be patented by the parent application. *Id.* In the present case, Fig. 2 is similar to the added microstructure of *Kennecott*. Fig. 2 depicts a physical property of the claimed product that was inherent and existing at the time of application – i.e. Fig. 2 graphically depicts a Western blot analysis using a monospecific antipeptide antibody used to detect the production of pmCS¹⁻⁷⁰⁴ or pmHAS¹⁻⁷⁰³ polypeptide that is functional truncated versions of pmHAS or pmCS missing the carboxyl terminus enhancing the utility for *in vitro* use.

In the present instance, the Applicants wish to add Fig. 2 which was not submitted originally due to a simple clerical oversight. In the present application there are 10 Figures which are discussed in the application. Fig. 1 was originally a two-page sequence listing comparison. Thus, there should have originally been a total 11 pages containing Figs. 1-10. It appears that a clerical error was made when the original application was filed: namely, that the clerk mistakenly believed that since there were 10 Figs. in the application, there should be 10 pages of figures. Obviously, this mistake was compounded by the fact that Fig. 2 was indeed missing from the stack of information.

As the Federal Circuit has held and the MPEP accurately reiterated, the addition of items to a specification does not raise issues of “new matter” when the information to be added was adequately described in the original specification and simply renders explicit an inherent property.

Thus, because the addition of Fig. 2 would add no new matter to the application as presently filed, Applicants respectfully petition the Commissioner to accept Fig. 2 into the application and grant the entire application, including Fig. 2, the original filing date of April 25, 2001.

Alternatively, should the Commissioner deny this petition the Applicants will amend the application to remove all reference to Fig. 2. In this manner, the original filing date can be maintained.

Respectfully submitted,



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